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NO. 1445 P. 1

PATENT APPLICATION

ATTORNEY DOCKET NO. 10014012 -1

IN THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Steven W. Trovinger

Confirmation No.: 4991

Application No.: 10/084460

Examiner: Mark T. Henderson

Filing Date: Feb 28, 2002

Group Art Unit: 3722

Title: Booklet Maker

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

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TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Sir:

Transmitted herewith is/are the following in the above-identified application:

- (X) Response/Amendment ( ) Petition to extend time to respond  
( ) New fee as calculated below ( ) Supplemental Declaration  
(X) No additional fee (Address envelope to "Mail Stop Non-Fee Amendment")  
(X) Other: Response to Restriction Requirement (fee \$                     )

CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY						
(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS	14	MINUS	22	= 0	X \$18	\$ 0
INDEP. CLAIMS	3	MINUS	3	= 0	X \$86	\$ 0
[ ] FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM					+ \$290	\$ 0
EXTENSION FEE	1ST MONTH \$110.00	2ND MONTH \$420.00	3RD MONTH \$930.00	4TH MONTH \$1480.00		\$ 0
OTHER FEES						\$
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$ 0

Charge \$ 0 to Deposit Account 08-2025. At any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16, 1.17, 1.19, 1.20 and 1.21. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

(X) I hereby certify that this paper is being transmitted  
to the Patent and Trademark Office facsimile  
number (703) 872-9302 on Oct 28, 2003  
Number of pages: 4  
Typed Name: Dee Timmons  
Signature: Dee Timmons

Steven W. Trovinger  
By Susan E. Heminger  
Susan E. Heminger  
Attorney/Agent for Applicant(s)  
Reg. No. 36,449

Date: Oct. 28, 2003

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**Inventor(s): **Steven W. Trovinger**Group Art Unit: **3722**Serial No.: **10/084460**Examiner: **Henderson, Mark T.**Filed: **February 28, 2002**Confirmation No.: **4991**Title: **Vertical Form Factor Booklet Maker**Atty Docket: **10014012-1**

Elect

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3 Loss

**Response to Restriction Requirement**

Sir:

This is in response to the restriction requirement mailed October 1, 2003 wherein the claims were grouped into the following categories:

- I. Claims 1-12, 21, and 22 drawn to a pivotable collecting device, classified in class 412, subclass 33.
- II. Claims 13-20, drawn to a method for folding sheet material, classified in class 493, subclass 405.

In response to the restriction requirement Applicant provisionally elects Claims 1-12, 21, and 22 (Group I) with traverse.

Applicant traverses the restriction requirement in view of the following remarks. According the restriction requirement

"Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP 806.05(e)). In this case the process as claimed can be practiced by another materially different process such as folding through the use embossing a sheet to create a fold line."

As stated above, according to MPEP 806.05(e), "The inventions are distinct if it can be shown that either: (1) the *process* as claimed can be practiced by another materially different *apparatus* or by hand . . ." (emphasis added). The present restriction requirement states that the basis for the restriction requirement is that "In this case the *process* as claimed can be practiced by another materially different *process* such as folding through the use embossing a sheet to create a fold line."

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(emphasis added). Applicant respectfully submits that the basis for the present restriction is in error since the requirement for showing distinctness according to MPEP 806.05(e) is that "the *process* as claimed can be practiced by another materially different *apparatus*" not "by another materially different *process*" as stated in the restriction. Applicant respectfully requests that the restriction be withdrawn in view of this error.

Regardless of this error, Applicant respectfully submits that the inventions are not distinct because the process of Claim 14 can not be practiced by another materially different apparatus than that recited in Claim 1. Specifically, Claim 14 of Category II process claims recites:

"14. A method of making booklets, comprising the steps of:  
clamping a folded sheet material with a *rotatable transferring device*;  
delivering the folded sheet material to a *pivotable collecting device*  
along an arc established by movement of the *rotatable clamping device*, the  
folded sheet material being deposited over a *supporting edge of the collecting device* such that a fold of the folded sheet material is received by the  
*supporting edge*; and  
pivoting the *collecting device* such that different portions of the folded  
sheet material are received by different supporting sides of the *collecting device*." (emphasis added)

Hence, the process as recited in the Category II claims must be practiced by an apparatus having at least a rotatable transferring device, pivotable collecting device, rotatable clamping device, supporting edge of the collecting device. Claim 1 of the Category I apparatus claims recites:

"1. A booklet maker, comprising:  
a *pivotable collecting device* including *two supporting sides* formed with  
a saddled shape; and  
a *rotatable transferring device* including a *displaceable clamping component*, wherein the *transferring device* delivers a folded sheet material to

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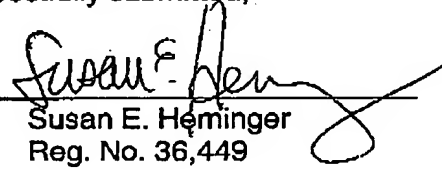
*the collecting device along a non-linear path, and the collecting device pivots to receive the folded sheet material from the transferring device such that different portions of the folded sheet material area support by different sides of the two supporting sides of the collecting device."* (emphasis added)

As can be seen, the Category I apparatus claims recite all of the structural limitations recited in the Category II process claims. Consequently, the process as recited in the Category II claims can only be practiced by the apparatus as recited in the Category I claims.

In view of the above remarks, withdrawal of the restriction is respectfully requested.

Respectfully submitted,

By

  
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Dated: October 24, 2003  
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